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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,574	09/22/2003	Kazuo Takaoki	2185-0706P	6442

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EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,574

Applicant(s)

TAKAOKI, KAZUO

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-30 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a request for continued examination (RCE) under 37 § C.F.R. 1.114, filed on September 14, 2005. Claims 1-12 were canceled, and new claims 13-30 were added. Claims 13-30 are pending.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13, 22, 23, 25-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36, 47, 48, and 63-65 of copending Application No. 10/220,022. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Present claim 13 is drawn to a process for producing a modified particle which contains a step consisting essentially of contacting: (a) BiL_m^1 , (b) $\text{R}_{t-n}^1\text{TH}_n$ ($T = \text{Gp } 15/16$; $n \neq 2$), and (c) a particle.

Claim 36 of the copending application is drawn to a process for producing a modified particle comprising the step of contacting: (a) M^1L_m^1 (M^1 is selected from group 15), (b) $\text{R}_{t-1}^1\text{TH}$ ($T = \text{Gp } 15/16$), (c) $\text{R}_{t-2}^2\text{TH}_2$, and (d) a particle, wherein (i) compound (a) is contacted with compound (b) to obtain a first contact product, then, contacting the first contact product with

particle (d) to obtain a second contact product, then contacting the second product with (c). In this case, the claim is drawn to a process which contains (open language) a step consisting essentially of contacting (a), (b), and (d).

Claims 22 and 47 both relate to a process for producing a catalyst component by contacting the modified particle with a Gp3-11/Ln metallocene. The process of claims 23 and 48 include an additional organoaluminum component. Claims 25-27 and 28-30 of the instant application and claims 63-65 of the copending application are drawn to processes for producing polymer (derived from ethylene and an α -olefin) in the presence of the claimed catalysts.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 17-20 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 13-16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 17 recites a process for producing a catalyst component, and claim 13 recites a process for producing a modified particle. All other limitations are identical, and thus, the difference between claims is a matter of nomenclature. That is, while the material is nominally different, the composition, and hence the identity of the material is the same.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 13-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogane (U.S. 2002/0143124) for the same reasons set forth in the previous office action (*q.v.*).

Key features will be highlighted herein. Ogane teaches a modified particle prepared by a process comprising contacting a particle with a compound of formula $M^1L_m^1$ (M^1 is bismuth atom, paragraph [0035]) and a compound of formula $R^1_{t-1}TH$ (R^1 is an electron withdrawing, halogenated hydrocarbon group, T is an oxygen, paragraphs [0047] and [0052]).

The order of contact of components is: substances (a) and (b) are contacted with particle (d), followed by contact with (c) (paragraph [0091]). A further aspect of the invention is a catalyst comprising the modified particle. In this case, the modified particle is contacted with an aluminoxane and a metallocene to produce a catalyst for polymerization of ethylene with α -olefins (paragraph [0220] and [0221]).

6. Claims 13-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Ogane (DE 101 64 188) for the same reasons elucidated in previous office actions. The German patent is essentially the same as the U.S. document.

Response to Arguments

7. Applicants traverse the rejection of claims over Ogane. Applicants' arguments have been considered fully, but they are not persuasive.

Applicants submit that the claims are not anticipated by the reference. One observes that the preamble of the claim recites, "a process...which contains a step consisting essentially of contacting the following (a), (b), and (c) a particle..." One also notes that the term, "consisting essentially of," limits the combination of elements *for that particular step only*. Thus, one would not combine (a), (b), (c), and another component (n) in the recited step because the claim language would exclude such an embodiment.

The open term, "containing," allows for other unrecited steps. Thus, one could combine (a), (b), and particle (c) in one step, and then combine the contact product of these materials with component (n) in a second step and still meet the limitations of the claimed process.

Ogane, indeed, discloses such a manipulation. One learns from paragraph [0091] that substances (a) and (b) are contacted with particle (d) in a first step. Here, Ogane's particle (d) is equated to particle (c) of the instant claims. In a subsequent operation, the resulting contact product is contacted with component (c). Here, component (c) is equated to component (n) in examiner's explanation.

As such, the rejection of claims under 35 U.S.C. 102 is valid and proper.

Applicant's declaration has been reviewed. The contents are insufficient in overcoming the rejection under 35 U.S.C. 102(a)/(e).[†]

[†] Unexpected results can not be a basis for patentability where a rejection under 35 U.S.C. 102 is applicable. *In re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549 (CCPA 1974).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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November 25, 2005


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